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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,136	01/03/2002	Radhika Aggarwal	RSW920010111US1	2414

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T81/062  
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EXAMINER

PITARO, RYAN F

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/041,136	Applicant(s) AGGARWAL ET AL.	
	Examiner Ryan F. Pitaro	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-13 have been examined.

***Response to Amendment***

2. Claims 1-13 are pending. This communication is responsive to Amendment B filed 3/13/2006. This action is non-final.

***Allowable Subject Matter***

Claims 5-6,8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and re-written to overcome the rejection under 35 U.S.C. 101.

The following is a statement of reasons for the indication of allowable subject matter: the prior art is silent in regards to a menu bar structure utilizing a table row and its cells to emulate a menu, and upon selection therein emulating a menu selection by changing the background color and replacing one of the cells with a graphical menu structure in combination with the prior art.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Art Unit: 2174

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-9,11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A menu emulation method is not statutory for at least the reason that is not tangibly embodied in a manner so as to be executable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,7,9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham ("Durham", US 7,032,183) in view of Alexander et al ("Alexander", US 5,986,654).

As per claim 1, Durham teaches a menu emulation method comprising: encoding a form-submit element with a menu-item description denoting a selectable menu (Column 9 lines 11-33, Figure 7); disposing said encoded form-submit element in network distributable markup and distributing said markup to a content browser (Column 10 lines 9-28); and, responsive to a selection of one of said menu-item description and

said graphical icon, further distributing over said network to said content browser a graphical menu-structure encoded in at least one additional form-submit element (Column 9 lines 49-67). Durham fails to distinctly point out an associated graphical icon denoting a selectable menu. However, Alexander teaches a form submit element with menu item description and an associated graphical icon (Column 8 lines 35-47, Column 9 lines 5-20). Therefore it would have been obvious to an artisan at the time of the invention to combine the graphical icon of Alexander with the menu emulation method of Durham. Motivation to do so would have been to provide a visually appealing rendition of a button.

As per claim 2, which is dependent on claim 1, Durham-Alexander teaches a menu emulation method, wherein said encoding step comprises: embedding in a markup representation of said form-submit element, a network reference to a server configured to produce enhanced graphical menu images, said network reference comprising a textual menu-item description and a menu type (Alexander, Column 9 lines 5-45, Column 10 lines 1-40).

As per claim 3, which is dependent on claim 1, Durham-Alexander teaches a menu emulation method, wherein said disposing step comprises: embedding said encoded form-submit element in network distributable markup defining a table cell in a table (Alexander, Column 9 lines 2-35, Durham, Column 9 lines 10-33); formatting said table cell with a background color matching the background colors of other table cells in

said table (Alexander, Column 9 lines 15-29, Durham Column 10 lines 30-36); and, distributing said markup, upon request, to a content browser (Alexander, Column 9 lines 15-29, Durham lines Column 9 lines 10-48).

As per claim 4, which is dependent on claim 3, Durham-Alexander teaches a method, wherein said step of further distributing a graphical menu-structure comprises: responsive to a selection of said encoded form-submit element embedded in said table cell (Durham, Figure 7, Column 9 lines 11-33), assembling a graphical menu-structure encoded in at least one additional form-submit element (Durham, Figure 7, Column 9 lines 33-47); replacing said encoded form-submit element embedded in said table cell with said graphical menu-structure; and, formatting said table cell with a background color which differs from the background colors of other table cells in said table (Durham, Column 10 lines 23-37).

As per claim 7, which is dependent on claim 4, Durham-Alexander teaches a method wherein said assembling step comprises generating a graphical display of a menu-structure, said display comprising at least one of a textual menu action, a graphically selectable menu action, and a nested menu structure (Durham, Figure 7).

As per independent claim 9, Durham-Alexander teaches a menu emulation method comprising: serving markup to a plurality of content browsers, said markup comprising at least one form-based input element encapsulating a reference to a

composite image of menu text (Durham, Column 9 lines 11-33, Figure 7); receiving an indication from at least one of said content browsers that said form-based input element has been selected (Durham, Figure 7, Column 9 lines 11-33); and, responsive to said receipt of said indication, further serving to said at least content browser a graphical image of a menu structure, said graphical image comprising at least one form-based input element encapsulating a reference to a composite image of menu text and a graphical icon, said icon denoting at least one of a menu action and a selectable menu (Durham, Figure 7). Durham fails to distinctly point out an associated graphical icon denoting a selectable menu each menu item being a composite image. However, Alexander teaches a form submit element with menu item description and an associated graphical icon (Column 8 lines 35-47, Column 9 lines 5-20). Therefore it would have been obvious to an artisan at the time of the invention to combine the graphical icon of Alexander with the menu emulation method of Durham. Motivation to do so would have been to provide a visually appealing rendition of a button.

Claim 10 is similar in scope to that of claim 9 and is therefore rejected under similar rationale.

As per independent claim 11, Durham-Alexander teaches a network distributable emulated menu comprising: a plurality of composite images, each said image comprising menu text (Durham, Column 9 lines 11-33, Figure 7); a plurality of selectable form-based input elements, each said element encapsulating one of said composite

images (Durham, Figure 7, Column 9 lines 11-33); and, a graphical image of a menu structure, said graphical image comprising at least one form-based input element encapsulating a reference to a composite image of menu text and a graphical icon, said icon denoting at least one of a menu action and a selectable menu (Durham, Figure 7, Column 9 lines 11-33). Durham fails to distinctly point out an associated graphical icon denoting a selectable menu and each menu item being a composite image. However, Alexander teaches a form submit element with menu item description and an associated graphical icon (Column 8 lines 35-47, Column 9 lines 5-20). Therefore it would have been obvious to an artisan at the time of the invention to combine the graphical icon of Alexander with the menu emulation method of Durham. Motivation to do so would have been to provide a visually appealing rendition of a button.

As per claim 12, which is dependent on claim 11, Richard teaches a menu, further comprising a plurality of table cells, each cell containing one of said selectable form-based input elements (Durham, Figure 7, column 9 lines 11-33).

As per claim 13, which is dependent on claim 13, Richard teaches a menu, wherein said menu structure comprises at least one of a textual menu action, a graphically selectable menu action, and a nested menu structure (Durham, Figure 7).

### ***Response to Arguments***



Applicant argues that the 101 rejection from the previous action is improper and that a non tangibly bodied method is not grounds enough for a rejection under 35 U.S.C. 101. However, the Examiner points out that functional descriptive material in combination with an appropriate computer readable medium (tangible embodiment) must be capable of producing a useful, concrete, and tangible result when used in a computer system. For example, Cf. In re Warmerdam – data structure stored in a computer memory and In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994)- data structure in a computer readable medium, wherein said computer readable medium must be a physical structure, not a signal, which permits the functionality to be realized with the computer. The combination of the method and a computer readable medium would render this a substantial practical application and therefore compliant under 35 U.S.C 101.

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F. Pitaro whose telephone number is 571-272-4071. The examiner can normally be reached on 7:00am - 4:30pm Mondays through Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ryan Pitaro  
Art Unit 2174  
Patent Examiner

RFP

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